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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,353	06/12/2001	Richard Carl Phelps	032658-016	7825

42015 7590 07/06/2005
POTOMAC PATENT GROUP, PLLC
P. O. BOX 270
FREDERICKSBURG, VA 22404

EXAMINER

CLEARY, THOMAS J

ART UNIT PAPER NUMBER

2111

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,353

Applicant(s)

PHELPS ET AL.

Examiner

Thomas J. Cleary

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-29 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-33, 35 and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 30-33, 35, and 37-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent Claims 30 and 39 recite the limitation "the bus... does not allow circulating empty packets". This limitation does not appear in the specification or the drawings, and Applicant has provided no guidance in the specification that would enable one of ordinary skill in the art to construct a bus that does not allow circulating empty packets without undue experimentation. Further, the specification states that "...whenever the bus is idle, the arbitration unit places empty packets on the bus at every available clock cycle. The empty packets travel along the bus, and may be used by any module that wishes to make a transaction" (See Page 31 Lines 18-24), and thus empty packets can be circulated.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 30-33, 35, and 37-39 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Independent Claims 30 and 39 recite the limitation "the bus...does not allow circulating empty packets". Claims 30 and 39 also recite the limitations "the arbitration unit is operable to issue empty packets during periods when the bus is idle, the empty packets being usable by a module to gain access to the bus..." (Claim 30), and "issuing empty packets from the arbitration unit during periods when the bus is idle" (Claim 39), and the specification states that "...whenever the bus is idle, the arbitration unit places empty packets on the bus at every available clock cycle. The empty packets travel along the bus, and may be used by any module that wishes to make a transaction." (See Page 31 Lines 18-24). The Cambridge Dictionary of American English defines "circulate" to mean "to move around or through". Thus, the empty packets issued on the bus by the arbitration unit are circulating on the bus, and this is contradicted by the limitation that "the bus...does not allow circulating empty packets", therefore making the invention inoperative.

Drawings

5. The drawings were received on 24 November 2004. These drawings are acceptable.

Response to Arguments

6. Applicant's arguments with respect to Claims 30-33, 35, and 37-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

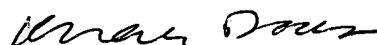
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Thomas J. Cleary whose telephone number is 571-272-3624. The Examiner can normally be reached on Monday-Thursday (7-3:30), Alt. Fridays (7-2:30).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rehana Perveen can be reached on 571-272-3676. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJC



Khanh Dang
Primary Examiner



Thomas J. Cleary
Patent Examiner
Art Unit 2111